REMARKS

Claims 1-13 are all of the claims pending in the application.

Claims 1 and 6 are amended herein in order to better define that which the Applicant regards as his invention. Support for the amendment to claim 1 may be found, for example, at page 4, line 6, and page 16, last line of the specification. Support for the amendment to claim 6 may be found, for example, at page 4, line 3 of the specification. No new matter is introduced, and entry of the amendments is requested.

Review and reconsideration on the merits are respectfully requested.

Rejections under 35 U.S.C. § 103(a)

Two rejections under 35 U.S.C. § 103 are posed.

At paragraphs 2-5, claims 1, 4-6 and 10-13 are rejected under 35 U.S.C. § 103(a) over NITTO DENKO CORPORATION (EP 0 816 462 A1, herein "Nitto Denko").

At paragraphs 6 and 7, claims 2-3 and 7-9 are rejected under 35 U.S.C. § 103(a) over Nitto Denko in view of Hartman et al. (U.S. Patent No. 5,476,712A, herein "Hartman").

Both these rejections are respectfully traversed, for the following reasons. Applicants submit that the cited references, either alone or in combination, do not render obvious any of claims 1-13 pending in the application. In the following response, the focus will be upon independent claims 1 and 6, because if these claims are allowed, dependent claims 2-5 and 7-13 will also be allowed.

In the present invention, the claimed layer structure is an unobvious improvement over the prior art because the combination of an inner subbing pressure-sensitive layer, as recited in amended claim 1, and the presence of at least some closed cells within the foamed structure,

together suppress the migration of deleterious materials from the foamed structure to the outermost PSA layer. This property is described generally at pages 3-4 of the specification. In claim 1, as amended herein, the subbing layer is expressly recited as an "inner subbing pressure-sensitive layer" and in claim 6, as amended herein, a "layer comprising a subbing base material" is expressly recited.

Applicants assert that neither of the cited references discloses these particular layer structures or their functions, much less the advantages obtained.

Specifically, it is Applicants position that neither Nitto Denko nor Hartman teaches a foam having at least some closed cells or a subbing layer. Therefore, Applicants assert that the cited references do not teach or suggest all of the elements of the rejected claims, as required.

The Examiner's position appears to be that the use of a foamed structure having at least some closed cells would have been *prima facie* obvious to prevent passage of air and other media. However, neither reference discloses such foams, nor the benefits of preventing such passage. Similarly, the Examiner appears to regard the particular claimed layer structure as *prima facie* obvious on the alleged grounds that Nitto Denko may separately disclose the composition of each layer of the claimed structure. However, the combined structure of the layers as claimed in claims 1 and 6 is not taught.

Applicants assert that the advantages of the combination of the use of a foamed structure having at least some closed cells and an inner subbing layer render the claimed invention unobvious over the cited art. Specifically, the claimed structure provides, through the combination of the closed cells and subbing layer, optimized subbing properties. Subbing is not taught in the cited art, and is therefore not recognized therein as a results-effective variable to be optimized through the

selection of a particular materials or the selection of one among many possible layer structures. Because only results-effective variables may be optimized, Applicants assert that the cited art cannot render the claimed invention obvious. MPEP 2144.05.

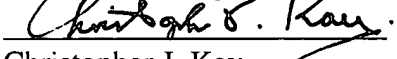
Further, because the cited art does not teach the benefits of a subbing layer, Applicants assert that one of ordinary skill would not have been motivated to alter the teaching of Nitto Denko (or the combination of Nitto Denko and Hartman) by the selection of a particular foam structure or combination of layers to arrive at the presently claimed invention. Similarly, there could have been no reasonable expectation of success in doing so because the subbing advantages of the present invention are not taught.

Accordingly, Applicants request that the rejections under 35 U.S.C. § 103 be withdrawn.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,



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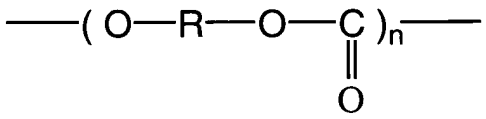
APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

The claims are amended as follows:

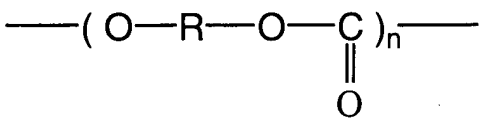
1. (Twice Amended) A waterstop sealing material comprising a foamed structure having closed cells or both closed cells and open cells, said foamed structure having two opposing surfaces, and a multi-layer pressure-sensitive adhesive layer provided on the first of said opposing surfaces, said multi-layer pressure-sensitive adhesive layer comprising an inner subbing pressure-sensitive layer and an outermost layer comprising a pressure-sensitive adhesive composition containing a polymer having a polycarbonate structure having a repeating unit represented by the following general formula:



wherein R represents a $C_{2\text{-}20}$ straight-chain or branched hydrocarbon group and n represents a positive integer, wherein the inner subbing pressure-sensitive layer and the outermost layer have different compositions.

6. (Twice Amended) A waterstop sealing material comprising a foamed structure having closed cells or both closed cells and open cells, said foamed structure having two opposing surfaces, and on the first of said opposing surfaces a layer comprising a subbing base material, and, as an outermost layer, a layer comprising a pressure-sensitive adhesive composition containing a polymer

having a polycarbonate structure having a repeating unit represented by the following general formula:



wherein R represents a $C_{2\text{-}20}$ straight-chain or branched hydrocarbon group and n represents a positive integer.